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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,559	03/02/2001	Reinhard Plaschka	JEK/PILASCHKA	3460

7590

03/27/2003

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 03/27/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/719,559

Applicant(s)

PLASCHKA ET AL.

Examin r

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the amendment mailed January 10, 2003.  
Claim 18,20,29 and 30 were amended and new claims 35-37 were added rendering claims 18-37 pending.

***Claim Rejections - 35 USC 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
  - a. The phrase "substantially high" in claim 20 is relative which renders the claim indefinite. The phrase "substantially high" is not defined by the claim as to a requisite degree.
  - b. The phrase "in comparison to other ingredients" in claim 20 is indefinite. Other ingredients is not defined.

***Claim Rejections – 35 USC § 102(b)***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 18, 24, 28 and 35 rejected under 35 U.S.C. 102(b) as being anticipated by Detrick et al (U.S. 5,161,829).

5. Detrick discloses a security paper (column 2, lines 14-18) comprising a coating of adhesive material (126) over a layer of paper (110) (column 9, lines 55-59) as shown in Figure 3. The adhesive layer lacks polyurethane and a filler substance. Detrick discloses the security paper is made of cotton fibers (column 3, lines 55-59).

***Claim Rejections – 35 USC § 103(a)***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 18-19, 21-28 and 35 rejected under 35 U.S.C. 103(a) as being unpatentable over Detrick et al (U.S. 5,161,829) in view of Martin (U.S. 5,601,683).

8. Detrick discloses a security paper (column 2, lines 14-18) comprising a coating of adhesive material (126) over a layer of paper (110) (column 9, lines 55-59) as shown in Figure 3. The adhesive layer lacks polyurethane and a filler substance. Detrick discloses the security paper enabling an indicia to be detectable in transmitted light and imperceptible on a photocopy made by utilizing reflected light (column 10, lines 28-46) where the security paper is made of cotton fibers and other known natural and synthetic

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fibers (column 3, lines 55-59). Detrick does not explicitly disclose a coating weight. The coating weight is an optimizable feature. It would have been obvious to one of ordinary skill in the art to optimize the adhesive layer because discovering the optimum or workable range involves only routine skill in the art. The coating weight directly affects the durability of the security paper. In re Aller 105 USPQ 233 and see In re Boesch, 617 USPQ 215. Detrick does not disclose a substance having at least one visually or machine detectable property in the coating. Martin teaches a security document comprising a coating mixture containing a printing means that is machine detectable (column 3, lines 37-60). Detrick and Martin are analogous art because they are from the same field of security documents. It would have been obvious to one of ordinary skill in the art to include a machine detectable property in the coating of Detrick because Martin teaches having this feature in the coating hinders the security document from being photocopied.

***Claim Rejections – 35 USC § 102(b)***

9. Claim 29-34 and 36-37 rejected under 35 U.S.C. 102(b) as being anticipated by Kaule (U.S. 5,817,205).
10. Kaule teaches making a security paper (column 3, lines 44-45 and column 6, lines 13-36) by applying a coat to the paper surface (column 5, lines 1-3) along with lacquers and printed protective layers (column 5, lines 59-65). Kaule teaches the paper comprising paper fibers (column 7, line 67) where the surface is suitable for producing

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isolated coated areas (column 8, lines 29-31). The reference discloses a paper machine cutting the paper to a desired size (column 9, lines 11-24). The coating of Kaule lacks both polyurethane and a filler substance.

### ***Response to Arguments***

11. Arguments made in regards to rejection made under 35 USC 112, second paragraph have overcome the rejection due to amendment of claim 20.

Arguments made in regards to rejection made under 35 USC 103(a) as being unpatentable over Edwards (U.S. 5,388,862) have been carefully considered and overcome the rejection because Edwards focuses on coating the security element in the paper versus coating the surface of the paper.

Arguments made in regards to rejection made under 35 USC 103(a) as being unpatentable over Edwards (U.S. 5,388,862) in view of Howland et al (U.S. 6,023,239) have been considered and overcome the rejection.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the

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examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
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